



Atty. Dkt. No. 016777-0344

DAC 10  
Box 1 seg

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Donald G. Munroe et al.  
Title: CLONED GLUCAGON-LIKE  
PEPTIDE-2 RECEPTORS  
Appl. No.: 09/331,127  
Filing Date: 10/19/1999  
Examiner: D. Fitzgerald  
Art Unit: 1647

**RECEIVED**

**SEP 22 2004**

**OFFICE OF PETITIONS**

**TRANSMITTAL OF PETITION TO REVIVE ABANDONED PATENT APPLICATION**

Mail Stop Petitions  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

In response to the Notice of Abandonment mailed on March 26, 2001, in the above-identified application, transmitted herewith are the following documents needed to revive the subject patent application in accordance with 37 C.F.R. § 1.137(b).

Enclosed are:

- [ X ] Petition to Revive an Application Abandoned Unintentionally under 37 C.F.R. § 1.137(b) (4 pages), and Exhibits A - D
- [ X ] Response to Notice to Comply with Requirements for Patent Applications Containing Nucleotide and/or Amino Acid Sequence Disclosures (1 page)
- [ X ] Statement to Support Filing and Submission in Accordance with 37 C.F.R. §§ 1.821-1.825 (1 page)
- [ X ] Sequence Listing (17 pages)
- [ X ] Computer Readable Format (CRF) of Sequence Listing
- [ X ] Amendment in Response to Notice Under 37 C.F.R. §§ 1.821-1.825 (7 pages)

09/21/2004 MBLANCO 00000005 09331127

01 FC:2453

665.00 OP

-1-

[ X ] Return Copy of Notice to Comply (3 pages)

[ X ] Check in the amount of \$665.00 in payment of the required fee under 37 C.F.R. § 1.17(m) (small entity)

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

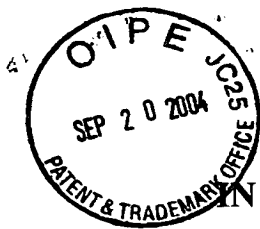
Respectfully submitted,

Date 9/20/04

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5538  
Facsimile: (202) 672-5399

By Eve Kim #46,785

for Michele M. Simkin  
Attorney for Applicants  
Registration No. 34,717



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#12

Applicants: Donald G. Munroe et al.  
Title: CLONED GLUCAGON-LIKE PEPTIDE-2  
RECEPTORS  
Appl. No.: 09/331,127  
Filing Date: 10/19/1999  
Examiner: D. Fitzgerald  
Art Unit: 1647

**RECEIVED**  
SEP 22 2004  
OFFICE OF PETITIONS

**PETITION TO REVIVE AN APPLICATION ABANDONED**  
**UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The above-identified application became abandoned for failure to file a timely and proper response to the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosure, mailed on August 7, 2000, which set a one-month period for response.

APPLICANTS HEREBY PETITION FOR REVIVAL OF THIS APPLICATION.

A grantable Petition to Revive pursuant to 37 CFR 1.137(b) requires the following items:

1. Required reply and/or fee;
2. Petition fee (37 C.F.R. § 1.17(m));
3. Statement that the abandonment was unintentional; and
4. Any required terminal disclaimer (37 C.F.R. § 1.137(c)).

**I. Required Reply and/or Fee**

The August 7, 2000 Notice states that the sequence disclosure fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825, and that Applicants must provide: (a) an initial or substitute computer readable form (CFR) copy of the "Sequence Listing"; (b) an initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification; and (c) a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. § 1.821(e), § 1.821(f), § 1.821(g), § 1.825(b), or § 1.825(d).

Filed herewith is a complete response to the August 7, 2000 Notice.

**II. Petition Fee**

A check in the amount of \$1,330.00 is enclosed for the amount stated in 37 C.F.R. § 1.17(m) to cover the fee for this petition.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

**III. Statement that the Abandonment was Unintentional**

Applicants hereby state that the entire delay in filing the required reply to the August 7, 2000 notice, from the due date until the filing of this Petition, was unintentional.

Specifically, as described in more detail below, Applicants and Applicants' current counsel became aware of the abandonment of the present application in August of 2004. In 2000, the present case was transferred to Foley & Lardner LLP from Applicants' prior counsel, Pennie & Edmonds. As the August 7, 2000 Notice to Comply and March 26, 2001 Notice of Abandonment were not received by Foley & Lardner LLP until August of 2004, presumably these documents were sent to Pennie & Edmonds.

Applicants or Applicants' current counsel, Foley & Lardner LLP, had no knowledge of the August 7, 2000 Notice or that the application was considered abandoned until a telephone communication on August 10, 2004, between a legal assistant of Foley & Lardner LLP, Heidi Hernandez, and Monica Young of the U.S. Patent and Trademark Office (USPTO). Ms. Young informed Ms. Hernandez of Applicants' failure to respond to the August 7, 2000 Notice. On August 30, 2004, Applicants' counsel inspected the USPTO's file jacket for Serial No. 09/331,127 to obtain copies of the August 7, 2000 Notice and the Notice of Abandonment. Copies of the August 7, 2000 Notice and the March 26, 2001 Notice of Abandonment are attached as Exhibits A and B, respectively.

A search of Applicants' file jacket for Serial No. 09/331,127 and docket records of Foley & Lardner LLP indicates that the August 7, 2000 Notice was not received. Foley & Lardner LLP maintains daily docket records of all replies due to the USPTO. The response due in connection with the August 7, 2000 Notice would have been due within one month of that date, *i.e.*, by September 7, 2000. The daily docket report for the responsible billing partner, Stephen A. Bent, for September 7, 2000 is enclosed in the sealed accompanying envelop as Exhibit C. As the daily docket report indicates, no document of any type relating to Serial No. 09/331,127 was docketed.

Further, Foley & Lardner LLP maintains an incoming mail record log of all USPTO communications. A copy of the pages for September 7, 2000-September 21, 2000 are included in the sealed accompanying envelop as Exhibit D. As the incoming mail record log indicates, no USPTO communications relating to Serial No. 09/331,127 were received between September 7, 2000-September 21, 2000.

Moreover, Foley & Lardner LLP maintains a Patent Record Sheet for every application for which it is responsible. All USPTO communications received for the application are recorded on the Patent Record Sheet. A copy of the Patent Record Sheet for Serial No. 09/331,127 is included in the sealed accompanying envelop as Exhibit E. As the Patent Record Sheet for Serial No. 09/331,127 indicates, no USPTO communications relating to Serial No. 09/331,127 were received.

Additionally, Serial No. 09/331,127 was filed on June 14, 1999 by another law firm, Pennie & Edmonds LLP. Serial No. 09/331,127 was transferred to Foley & Lardner LLP on May 3, 2000. Foley & Lardner LLP subsequently filed a Revocation Of Prior Powers Of

Attorney By Assignee, Appointment Of New Power Of Attorney By Assignee, and Change of Correspondence Address on July 2, 2001. The USPTO accepted the Revocation Of Prior Powers Of Attorney By Assignee, Appointment Of New Power Of Attorney By Assignee, and Change of Correspondence Address on July 16, 2001.

The information contained in the documents submitted with this petition as Exhibits C and D is **proprietary** and is submitted only for the purpose of rendering a decision on the subject petition. Once a favorable decision on this petition has been reached, it is respectfully requested that the **proprietary information be expunged** from the records of the subject application and returned to Applicants.

Accordingly, the entire delay in filing the required reply to the August 7, 2000 notice, from the due date until the filing of this Petition, was unintentional.

**IV. Any Required Terminal Disclaimer (37 C.F.R. § 1.137(c))**

No terminal disclaimer is required in this application under 37 C.F.R. § 1.137(c) since this application was not filed before June 8, 1995.

V. Conclusion

Granting of Applicants' Petition to Revive is respectfully requested

Respectfully submitted,

Date 9/20/04

By Ave Lim #46,785

FOLEY & LARDNER LLP

Customer Number:

22428

PATENT TRADEMARK OFFICE

Telephone: (202) 672-5538

Facsimile: (202) 672-5399

for Michele M. Simkin  
Attorney for Applicant  
Registration No. 34,717

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.



EX-A  
UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

|                    |                   |        |                       |                               |
|--------------------|-------------------|--------|-----------------------|-------------------------------|
| APPLICATION NUMBER | 10/11 FILING DATE | MUNROE | FIRST NAMED APPLICANT | D ATTORNEY DOCKET NO. 023-999 |
|--------------------|-------------------|--------|-----------------------|-------------------------------|

PENNIE & EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

HM12/0326

ANDREXAMINER

ARTICLE PAPER NUMBER

03/26/01

DATE MAILED:

### NOTICE OF ABANDONMENT

This application is abandoned in view of:

- ☒ Applicant's failure to timely file a proper response to the Office letter mailed on 8/7/00 (LETTER OF NON-COMPLIANCE WITH SEQUENCE RULES)
- ☐ A response (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_, which is after the expiration of the period for response (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
- ☐ A proposed response was received on \_\_\_\_\_, but it does not constitute a proper response to the final rejection.
- (A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC).)
- ☐ No response has been received.
- ☐ Applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.
- ☐ The issue fee (with a Certificate of Mailing or Transmission of \_\_\_\_\_) was received on \_\_\_\_\_.
- ☐ The submitted issue fee of \$ \_\_\_\_\_ is insufficient. The issue fee required by 37 CFR 1.18 is \$ \_\_\_\_\_.
- ☐ The issue fee has not been received.
- ☐ Applicant's failure to timely file new formal drawings as required in the Notice of Allowability.
- ☐ Proposed new formal drawings (with a Certificate of Mailing or Transmission of \_\_\_\_\_) were received on \_\_\_\_\_.
- ☐ The proposed new formal drawings filed \_\_\_\_\_ are not acceptable.
- ☐ No proposed new formal drawings have been received.
- ☐ The express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on \_\_\_\_\_.
- ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a) upon the filing of a continuing application.
- ☐ The decision by the Board of Patent Appeals and Interferences rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ The reason(s) below:

Gay L. King





EX.B  
**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

20

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/331,127 10/19/99 MUNROE

D 8607-023-999

PENNIE & EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

HM22/0807

|          |
|----------|
| EXAMINER |
|----------|

|               |              |
|---------------|--------------|
| FITZGERALD, D |              |
| ART UNIT      | PAPER NUMBER |

1647

DATE MAILED:

08/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: Commissioner of Patents and Trademarks  
Washington, D.C. 20231

09/331,127

|               |          |                       |                     |
|---------------|----------|-----------------------|---------------------|
| SERIAL NUMBER | INVENTOR | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|----------|-----------------------|---------------------|

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| EXAMINER |
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|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

6

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). However, it fails to comply with the requirements of 37 CFR §§ 1.821-1.825 as set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

APPLICANT IS GIVEN ONE MONTH FROM THE DATE OF THIS LETTER WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 CFR §§ 1.821-1.825.

Failure to comply with these rules will result in **abandonment** of the application under 37 CFR § 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR § 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Any inquiry concerning this communication should be directed to the undersigned at telephone number (703) 308-3934 or fax number (703) 308-0294. Inquiries of a general nature or relating to the status of the application should be directed to the Technology Center 1600 receptionists at (703) 308-0196.

DAVID L. FITZGERALD  
PRIMARY EXAMINER  
ART UNIT 1647

2 August 2000

# **NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. §§ 1.821-1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990, and at 55 FR 18230, May 1, 1990.
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. § 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. § 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. §§ 1.822 and/or 1.823, as indicated on the attached copy of the marked-up "Raw Sequence Listing".
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 C.F.R. § 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. § 1.821(e).
- ☐ 7. Other:

## **Applicant must provide:**

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. § 1.821(e) or § 1.821(f) or § 1.821(g) or § 1.825(b) or § 1.825(d).

For questions regarding compliance with these requirements, please contact one of the following:

For rules interpretation, call (703) 308-4216.  
For CRF submission help, call (703) 308-4212.  
For PatentIn software help, call (703) 557-0400.

**Please return a copy of this notice with your response.**



2.8

# Patent Record Sheet

|                     |   |                                     |  |
|---------------------|---|-------------------------------------|--|
| Docket ID           | 016777-0344   | Other Party                         | <input type="checkbox"/>                         |
| Alternative ID      |   | File Reference                      |  |
| Applicant/Patentees | NPS Allelix Corp. and NPS Pharmaceuticals, INC.                         | Operating Group                     | NPS Allelix Corp.                                |
| Cost Centres        |   | Attorneys                           | Bent Stephen A., Frank Eve L., Simkin Michele M. |
| Inventors           | Munroe Donald G, Gupta Ashani K, Vyas Tejal B, McCallum Kirk, Fan Ermei | Office                              | Washington, D.C.                                 |
| Country             | United States of America  | Prosecuting/Admin Agent             |  |
| Short Title         | CLONED GLUCAGON-LOKE PEPTIDE 2 RECEPTORS                                | Representative Agent                |  |
|                     |   | Tax Receiver / Patent Office        | Denneweyer & Co. Luxembourg                      |
| Convention          | Priority  | Application No                      | 09/331127  |
| Origin              |   | Application Date                    | 19-Oct-1999                                      |
| Type                | Patent  | Grant No                            |  |
| Sub Type            | Regular   | Grant Date                          |  |
| Status              | Pending   | Independent Claims                  | 0  |
| Sub Status          | FIRST FILED US DATE   | Number of Dependent Claims          | 0  |
|                     |   | Number of Multiple Dependent Claims | 0  |

License of Right ☐

Small Entity ☒

File Status

Annuity Instructions

Claimed Priorities & Parent Records

Long Title

Abstract Summary

Memo

International Classes

National Classes

Keywords

Products

Practice Group

Prior Art

Literature

Patents/Inventions

Related Cases

Diary

| Docketed | Action / Event | Recorded No | Reminder | Due | Done/Record | Resp Party |
|----------|----------------|-------------|----------|-----|-------------|------------|
|          | Memo           |             |          |     |             |            |

## Patent Record Sheet

|             |                     |           |             |
|-------------|---------------------|-----------|-------------|
| 03-Nov-2001 | IDS NOT APPLICABLE  |           |             |
| 03-Nov-2001 | SMALL ENTITY STATUS |           | BN          |
| 04-Nov-2001 | First Filed Date    |           | 13-Dec-1996 |
| 03-Nov-2001 | Application Date    | 09/331127 | 19-Oct-1999 |
| 03-Nov-2001 | IDS EXTENDED        |           | 07-Jul-2000 |

### Additional Fields

Claimed Invention 0

Assigned

Family ID INV-25328

*Date created* 03-May-2000

*Created by* HMSYSTEM

*Date Amended* 16-Aug-2004

*Updated by* LBELL